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**Supreme Court of the United States**

OCTOBER TERM, 1947

No. 244

EUPHIME V. BERESLAVSKY,  
(Plaintiff in Civil Action No. 26-575 against Socony-  
Vacuum Oil Company, Incorporated),

—v.—

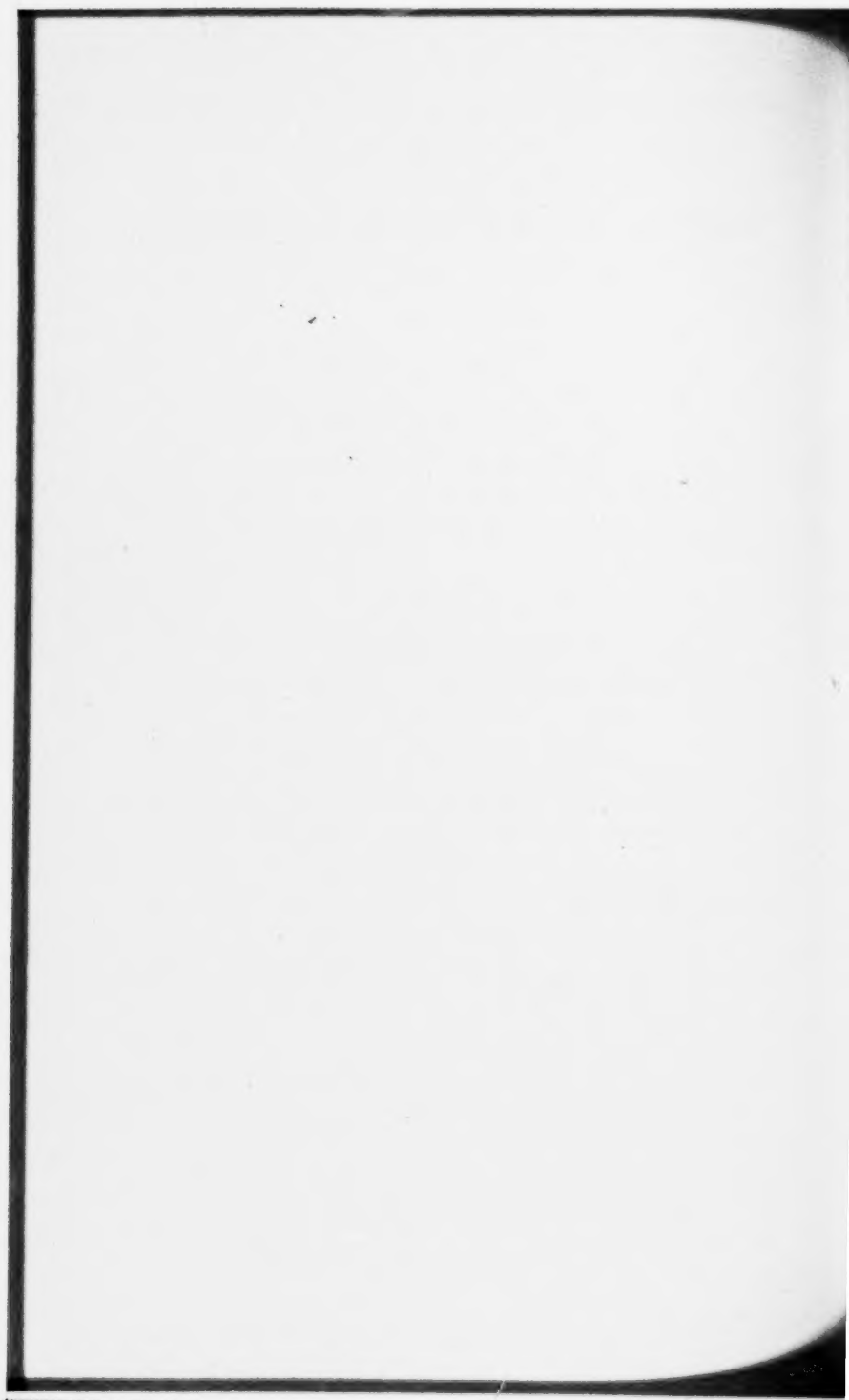
FRANCIS G. CAFFEY,  
United States District Judge for the Southern District  
of New York,

*Respondent and Petitioner.*

PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE SECOND CIRCUIT AND BRIEF IN  
SUPPORT THEREOF

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FRANCIS G. CAFFEY,  
United States District Judge for the Southern District  
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*Respondent and Petitioner.*

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**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE SECOND CIRCUIT**

*To the Honorable the Chief Justice and Associate Justices  
of the Supreme Court of the United States:*

Your petitioner, a District Judge of the District Court of the Southern District of New York, respectfully prays for a writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit to review the judgment of that Court, on a petition for writ of mandamus, granting such petition and issuing a writ directing your petitioner

to vacate an order of petitioner striking plaintiff's demand for trial by jury in a civil action, *Bereslavsky v. Socony-Vacuum Oil Company, Incorporated*, No. 26-575.

A certified transcript of such part of the record in said civil action as is material to the review of said judgment is furnished herewith in compliance with Rule 38 of this Court.

### **Jurisdictional Statement**

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925, Ch. 229 (28 U. S. C. Sec. 347).

### **Summary Statement of Matters Involved**

The matter involved is whether in a patent infringement action, plaintiff has waived his right to a jury trial by having failed to serve a demand within ten days after service of the last pleading directed to the issues raised by his complaint demanding an injunction and damages or, can such plaintiff recover the right to a jury trial so waived merely by amending his complaint striking out the prayer for equitable relief and serving a demand under Rule 38 of the Federal Rules of Civil Procedure within ten days after such amendment.

Rule 2 of the Rules of Civil Procedure provides:

"There shall be one form of action to be known as 'civil action'."

"Rule 38. Jury Trial of Right.

"(a) RIGHT PRESERVED. The right of trial by jury as declared by the Seventh Amendment to the Constitution or as given by a state of the United States shall be preserved to the parties inviolate.

"(b) DEMAND. Any party may demand a trial by jury of any issue triable of right by a jury by serving upon the other parties a demand therefor in writing at any time after the commencement of the action and not later than 10 days after the service of the last pleading directed to such issue. Such demand may be indorsed upon a pleading of the party.

"(c) SAME: SPECIFICATION OF ISSUES. In his demand a party may specify the issues which he wishes so tried; otherwise he shall be deemed to have demanded trial by jury for all the issues so triable. If he has demanded trial by jury for only some of the issues, any other party within 10 days after service of the demand or such lesser time as the court may order, may serve a demand for trial by jury of any other or all of the issues of fact in the action.

"(d) WAIVER. The failure of a party to serve a demand as required by this rule and to file it as required by Rule 5 (d) constitutes a waiver by him of trial by jury. A demand for trial by jury made as herein provided may not be withdrawn without the consent of the parties."

### SUMMARY OF FACTS

The question arises in action for patent infringement brought in the United States District Court for the Southern District of New York by *Euphime V. Bereslavsky* against *Socony-Vacuum Oil Company, Incorporated*, August 8, 1944. The complaint states that the action arises under Section 4921, as amended, U. S. Code, Title 38, Sec. 70; and demanded injunctive relief and an accounting for profits and damages. Issue was joined by the filing of an

answer on October 30, 1944. An amendment to the answer was filed on February 2, 1945.

No demand for jury was made by either party within the time prescribed by Rule 38 of the Federal Rules of Civil Procedure.

The patent in suit expired May 21, 1946.

On August 22, 1946, plaintiff moved the court for leave to amend his complaint, by stating that the action arises under Sec. 4919 U. S. Code, Title 35, Sec. 67, and demanded judgment against defendant for the sum of two million, five hundred thousand dollars. The motion was heard on September 10, 1946, and on September 19, 1946, Mandelbaum, D. J., rendered an opinion granting the motion, in which opinion he said in part (R. p. 8):

"The defendant questions the necessity of this amendment. This objection is not altogether without merit. Under the Federal Rules of Civil Procedure, which have done away with procedural distinctions between law and equity (*Grauman vs. City Company of New York*, 31 F. Supp. 172, 173) it would appear that the amendment sought is unnecessary since the request for injunctive relief could be abandoned at trial and the issue of damages tried by the court. However, I can see no harm in granting the amendment which leaves the complaint as it was in every respect except for the elimination of the request for injunctive relief."

And stated further in the opinion:

"It is claimed that the sole purpose of the amendment is to obtain a jury trial, a right which plaintiff has long ago waived. This question is not before me and is purely anticipatory."

On September 30, 1946, an order was entered on Judge Mandelbaum's opinion permitting the amendment of the complaint in the respects there enumerated. On the same date, September 30, 1946, plaintiff served a demand for trial by jury.

No answer to the amendment of the complaint has been served or filed. The answer of October 30, 1944 and its amendment of February 2, 1945 are the last pleadings directed to the issues. No new denials are required as the issues remain the same.

On October 3, 1946, the defendant, Socony-Vacuum Oil Company, Incorporated, moved to vacate plaintiff's jury demand on the ground that under Rule 38 plaintiff had waived his right to a jury trial on the issue of patent infringement and damages and that the discretion of the Court to grant the demand under Rule 39 should not be exercised.

The motion was duly heard and after petitioner had considered the issue of compliance with Rule 38 of the Rules of Federal Procedure and the matter of discretionary relief, and after petitioner had heard additional argument and had concluded that plaintiff had waived trial by jury as a matter of right by his failure to serve a demand within ten days after the service of the last pleading, and that he had also failed to show sufficient reason why petitioner should in the exercise of his discretion grant a jury trial, an order was made and entered by petitioner on February 17, 1947, granting the defendant's motion and striking the plaintiff's demand for jury (R. p. 15).

Plaintiff then filed a petition in the United States Circuit Court of Appeals for the Second Circuit for a Writ of Mandamus (R. p. 2) directing your petitioner to vacate the order striking the plaintiff's demand for a jury. After argument, the petition was granted (*Bereslavsky v.*

*Caffey*, 161 Fed. 2nd 499) and a writ issued directing the respondent, your petitioner, to vacate the order striking the jury demand, the court holding that, under the original complaint, "the plaintiff was not entitled to demand a jury, since the relief he then sought was wholly 'in equity', so that there was then no issue triable of right by a jury".

### **Questions Presented**

Where a civil action is initiated by a single complaint which raises issues "triable of right by a jury" (infringement, validity and damages) and which also seeks equitable relief (injunction);

- (a) Is the relief sought by such complaint "exclusively in equity" so that neither party can demand a jury trial of any issue under the provisions of Rule 38 (b), and if so
- (b) Can the plaintiff, by filing such a complaint, deprive the defendant of his right to a jury trial on any issue and at the same time have such right preserved for himself merely by amending his complaint at any time to strike the prayer for equitable relief, or
- (c) Must the plaintiff to preserve his right to a jury trial combine in the complaint a separate statement of his cause of action which contains no prayer for equitable relief?

### **Reasons Relied on for the Allowance of the Writ**

The reasons for petitioning a review on *writ of certiorari* are the following:

The Circuit Court of Appeals for the Second Circuit (*Bereslavsky v. Caffey, supra*) has rendered a decision in

conflict with decisions of District Courts on the same matter which had established a settled practice.

The Circuit Court of Appeals for the Second Circuit (*Bereslavsky v. Caffey, supra*), has rendered a decision in conflict with a decision of the Circuit Court of Appeals for the Ninth Circuit (*Bruckman v. Hollzer*, 152 Fed. 2nd 730).

The Circuit Court of Appeals for the Second Circuit (*Bereslavsky v. Caffey, supra*), has decided that (regardless of the Rules of Civil Procedure adopted by the Supreme Court uniting the general rules for cases in equity with those in actions at law so as to secure one form of civil action and procedure for both) in a civil action involving an issue triable of right by a jury and an issue of relief triable only by a court, the relief sought remains exclusively "in equity" and that the action is triable only by a court but permitted an amendment not addressed to the issues, to recreate a right to demand trial by jury, long since waived, and thus vitiate the control of Rule 38 requiring demand within 10 days of the last pleading addressed to the issues. This decision, which petitioner believes conflicts with the Rules, especially Rule 38, involves a holding with respect to a fundamental question of the constitutional right to trial by jury that petitioner believes is contrary to the letter and spirit of the Rules and affects actions now pending and that will be brought from time to time and which it is important and even necessary that the Supreme Court should decide for the guidance of federal courts in administering the Rules.

Since your petitioner's decision striking plaintiff's jury demand followed a practice which your petitioner believes to have been established by the weight of judicial decisions in other cases involving a joinder of issues, one triable by a jury and the other triable only by a Court (involving es-

sentially the same state of facts as in the instant case), and since it has been held in the United States Circuit Court of Appeals in the Ninth Circuit that the joinder of an action for damages and an action for equitable relief does not preclude a jury trial on the issue of damages (all these cases being cited in the brief, pp. 12, 13, 14 hereto annexed) your petitioner submits that in the exercise of sound judicial discretion, this Court should determine whether in cases involving two such issues either party has the right to demand a jury trial on an issue which would be triable as of right by a jury if such issue were not joined with an issue of equitable relief. If the decision of the appellate court in the mandamus proceeding is correct, injustice has been suffered by parties to other actions who have been denied their constitutional right of trial by jury; while in other actions probably now pending or which may hereafter be brought, the same question may have arisen or may arise and the courts having jurisdiction thereof must resolve the question in the face of conflicting decisions. While your petitioner believes that the decision of the Circuit Court of Appeals for the Second Circuit is erroneous, petitioner prays for a review of all the decisions primarily in order that federal courts of original jurisdiction may have the judgment of this Court so as to insure uniformity of decisions and insurance against either the unjust denial of a constitutional right to either a plaintiff or a defendant, or the unjust compulsion of either party to submit to a trial by jury if the right of the other party thereto has been waived.

WHEREFORE, your petitioner prays that this petition be granted.

HERBERT C. SMYTH, JR.,  
FRANK S. BUSSEY,  
*Attorneys for Petitioner.*

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FRANCIS G. CAFFEY,

United States District Judge for the Southern District  
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*Respondent and Petitioner.*

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**BRIEF IN SUPPORT OF PETITION FOR WRIT OF  
CERTIORARI**

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**Opinions of the Courts Below**

The opinion of petitioner in the District Court is set forth in the transcript of the record (R. p. 15).

The opinion of the Court below is set forth in the transcript of the record, page 28, and reported at 161 Fed. 2nd 499.

The Mandate of the Circuit Court of Appeals, entered on May 7th, 1947 is attached to the record hereof (R. pp. 31, 32) and certified by the Clerk of the Circuit Court of Appeals to this Court.

## ARGUMENT

### POINT I

**The decision of the Circuit Court of Appeals, Second Circuit, conflicts with the principles enunciated in the opinions of the District Courts and with their decisions.**

Your petitioner, a judge of the District Court of the United States, raises a fundamental question the answer to which is required for the guidance of federal courts in administering the Rules of Federal Procedure in many cases now pending. In framing these Rules and thus uniting the general rules prescribed for cases in equity with those in actions at law so as to secure one form of civil action and procedure for both, under the authority of the Act of June 19, 1934, Ch. 651, this court has done away with the procedural distinctions between law and equity. The specific question raised by this petition is whether, in an action raising an issue triable as of right by a jury but also demanding equitable relief and triable only by a court, either party may demand a trial by jury of the first issue. The United States Circuit Court of Appeals for the 2nd Circuit, holds in its opinion (161 F. 2nd 499) that—

“ \* \* \* For, under that complaint, the plaintiff was not entitled to demand a jury, since the relief he then sought was exclusively ‘in equity’, so that there was then no ‘issue triable of right by a jury’. When, by amending his complaint, he abandoned his prayer for such ‘equitable’ relief, he then, for the first time, was in a position to demand a jury, for only then did there come into being an issue ‘triable of right by a jury’ \* \* \* ” (p. 500).

The appellate court goes on to say that—

“Defendant seems to suggest that the Rules have completely obliterated, for all purposes, the historic differences between ‘law’ and ‘equity’ ” (p. 500).

This was not, and is not, petitioner’s position. His position is that the substantive distinction between “law” and “equity” remains but that the procedural distinction has been abolished by the Rules. Petitioner’s interpretation of Rule 38 is that it clearly contemplates the joinder in one action of “an issue triable of right by a jury” and an issue—equitable relief—not so triable. If this interpretation of Rule 38 is correct, it must be conceded that plaintiff failed to serve a demand for jury trial on the issue triable of right by a jury within the time provided by the Rule, that the right to trial by a jury of that issue was waived, and that, after the prayer for equitable relief was abandoned and demand then made for a jury trial, petitioner was right in striking the demand.

It is expressly provided in the Act of June 14, 1934, that in the union of rules which the Supreme Court was authorized to make “the right of trial by jury as at common law and declared by the seventh amendment to the Constitution shall be preserved to the parties inviolate”.

Before the going into effect of the Rules it is conceded that the procedure was that where any issue that if raised alone would have been triable as of right by a jury was united with a prayer for equitable relief, the case was triable only by the court. It is petitioner’s position that this procedure has been abolished by the Rules.

Under the old procedure the plaintiff could elect, by uniting the two issues in a single complaint, to deprive the defendant of the right to a jury trial on every issue. Under Rule 38, as petitioner interprets it, defendant is not de-

prived of this right; either party can demand a jury trial on an issue which, if not united with a prayer for equitable relief, would have been triable as of right by a jury under the old procedure.

The opinion of the appellate court fails altogether to expressly interpret Rule 38, which was the sole question before the court. By necessary inference, the court either interpreted Rule 38 as applicable only to cases in which all the issues were triable of right by a jury, or as negating the legal right of the Supreme Court to make the Rule.

In striking plaintiff's demand for a jury trial, petitioner followed prior decisions in cases presenting essentially the same facts as those in the instant case:

*Sterling Products Corp. v. Sterling Drug, Inc.*, 6 Fed. Rules Serv., 488, at p. 489 (S. D. N. Y.);

"It is perfectly apparent that the only reason why the plaintiff desires to amend the complaint is to enable it to get a jury trial to which it is not entitled."

. . . . .

"If the plaintiff wishes to abandon this phase of his prayer for relief, it may do so on the trial and proceed on the issue of damages, but it may not at this late date, through the device of amending the complaint, change a nonjury action into a jury action. See, *Stewart-Warner Corp. v. Staley*, 2 F. R. D. 446 (6 Fed. Rules Serv. 38b.12, Case 3)."

*Munkacsy v. Warner Bros. Pictures, Inc.*, 6 Fed. Rules Serv., 485, at p. 486 (E. D. N. Y.);

"To the same effect see Holtzoff, *New Federal Procedure and the Courts*, p. 109, 'The time within which such a demand may be served is not extended by the service of amended pleadings (Rules 38 and 39; Bug-

geln & Smith, Inc. v. Standard Brands, Inc. (S. D. N. Y.), 27 F. Supp. 399), unless, of course, an amended pleading introduces new issues triable by a jury \* \* \* ”

*Stewart-Warner Corp. v. Staley*, 2 Fed. Rules Decisions 445 at p. 447 (W. D. Penn.);

“The proposed amended complaint charges defendant with infringement of this Zerk patent, but omits the prayer for an injunction and an accounting, merely asking for a judgment for \$4500 damages on account of the alleged infringement. In this proposed amended complaint plaintiff demands a jury trial. The plaintiff was not entitled to a jury trial on the issues raised by the complaint, and answer, as originally filed in 1937.

“The evident purpose for amending its complaint is merely an attempt on the part of the plaintiff to secure a jury trial to which it was not entitled in the action as originally brought. If we were to apply Rule 38b of the Rules of Civil Procedure in this case (not in force when this action was brought), the plaintiff’s demand for a jury trial is too late, not having made its demand therefor in writing within ten days after the service of the last pleading directed to the issue of patent infringement. The issues involved in the ordinary patent suit are such that we would not ordinarily avail ourselves of the provisions of Rule 38b to order a jury trial on those issues.”

*Mealy v. Fidelity National Bank in New York*, 6 Fed. Rules Serv., 484, at p. 485 (E. D. N. Y.);

“By the service of the amended complaint, a new action was not instituted, but the then-existing action was continued with substantially no change in the first and second causes of action, as to which no Jury trial had been requested, or demanded.

"About two years have elapsed since the action was instituted, and plaintiff has never, during all of that time, offered any reasonable and satisfactory excuse for his failure to demand a jury trial within ten days after the original issue was joined, and he is not now entitled to a jury trial on the first and second causes of action, \* \* \*"

*Waldo Theatre Corporation v. Dondis, et al.*, 1 Fed. Rules Decisions, 685, at pp. 687, 688 (S. D. Maine);

"The plaintiff's position is apparently based on the erroneous assumption that a trial is still—as it was at common law—a trial of the whole case as an indivisible entity; where as it is now, or may be, a collection of issues which may be separately handled. An action may now be split up into issues which may be tried separately, some with a jury and some without" (p. 687).

\* \* \* \* \*

"I do not find any reported decisions on the question involved, but it is analogous to the point raised at the New York Symposium on the Rules, reported in pp. 309, 310 of those proceedings where the question propounded was whether, if the plaintiff fails to seasonably demand a jury trial, and thereafter amends its complaint, it may demand a jury trial at a later date. The answer suggested that a jury trial may be demanded only on any new issues introduced by the amendment and not as to the former issues. I regard the principle applied there as correct and applicable here. The plaintiff is entitled to a jury trial only on the new issues raised by the supplemental complaint" (p. 687).

\* \* \* \* \*

"It is quite clear that the new rules favor a trial of issues by a jury only when that is the best tribunal to decide them. There could hardly be a more ineffective or unsatisfactory tribunal than a jury for such a case as this" (p. 688).

The apparently settled practice established by the District Court cases above cited may be thus briefly stated:

If, by an amendment, a new issue (triable by jury) is pleaded the defendant can demand a jury trial on that new issue, but he cannot demand a jury trial on an original issue merely by repleading it by an amendment. If there are two issues in the original pleading (one triable by a jury and the other by the court) and if amendment merely eliminates one issue, an amendment that repleads the other issue is not "a last pleading directed to such other issue" in the sense of Rule 38, and if there was no demand for a jury trial within the time provided by Rule 38, the resultant waiver of the right to demand a jury trial is binding and final.

None of these District Court decisions was considered in the opinion of the Circuit Court of Appeals, although all were cited and in detail discussed in petitioner's brief.

A reported District Court case which it is difficult to reconcile with the above cited cases is *Bellavance v. Plastic Craft Novelty Co., et al.*, 36 Fed. Supp. 37 (1939) in which the plaintiff claimed both injunction and damages and placed the case on the jury calendar. Defendant's motion to strike the action from the jury calendar was granted. The Court said at page 39,

"The distinction between Law and Equity, abolished by the new rules, is a distinction in procedure and not a distinction between remedies."

If the plaintiff had demanded a jury trial only on the issue of damages, it cannot be conclusively assumed that the court would have allowed defendant's motion.

That by the amendment of the complaint the cause of action was shifted from Section 4921 R. S. to Section 4919 R. S. is not significant, since both the District Court (Mandelbaum, D. J. in allowing the amendment R. p. 9) and the appellate court (in its opinion R. p. 28) properly considered the amendment as involving a mere abandonment of the prayer for injunctive relief. While, under the old practice, an action under Sec. 4921 R. S. was a suit in equity, and an action under Sec. 4919 R. S. was an action at law, under the new practice both are Civil Actions. In both sections the provisions as to recovery of general damages are the same. In Sec. 4919 the damages assessed are damages "found by the verdict as the actual damages sustained". Sec. 4921 provides that "the Court may adjudge and decree the payment by defendant to the complainant of a reasonable sum as general damages for the infringement". Sec. 4921 provides also that the Court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case (Sec. 4919). Both the District Court and the Circuit Court of Appeals correctly treat the amendment, not as a new civil action, but as a mere abandonment of the prayer for equitable relief.

If the decision of the appellate court in the instant case be assumed to be sound, the plaintiffs in the District Court cases above cited were improperly denied their constitutional right of trial by jury on issues of right triable by a jury, since a plaintiff might at any time up to the very date of the hearing abandon his claim for equitable relief and demand a jury trial. And on the same assumption a

plaintiff can deprive a defendant of his right to trial by jury of issues triable of right by a jury by the simple expedient of adding a claim for equitable relief. And in the present case defendant is deprived of its right, under the waiver clause of Rule 38, to have all issues tried by the court.

## POINT II

**The instant decision of Circuit Court of Appeals, Second Circuit, is in apparent conflict with a prior decision of the Circuit Court of Appeals, Ninth Circuit.**

The Circuit Court of Appeals for the Ninth Circuit in *Bruckman v. Hollzer*, 152 Fed. 2nd 730, had before it a complaint which demanded damages, an injunction and an accounting of profits. The instant complaint before the change made in its prayer sought " \* \* \* a preliminary and final injunction against further infringement by defendant and those controlled by defendant, an accounting for profits and damages, \* \* \* ". Plaintiff in the *Bruckman* case, duly demanded a jury trial within ten days of the last pleading, the answer, and the demand was restricted to the issues seeking damages. Defendants' motion to strike the demand was denied and they petitioned the Circuit Court of Appeals, Ninth Circuit, to compel the district judge to strike the jury demand. The Court, in its opinion denying the petition, observed that the plaintiff contended that the Federal Rules of Civil Procedure

" \* \* \* now give to the party having a claim triable by jury at common law the power to preserve that right when that claim is joined with other equitable claims involving one of the issues of fact in the common law suit" (p. 732).

The Court further said in its opinion (p. 732):

"If this contention be correct, it is obvious that, since the issue of infringement is common to all three sets of transactions, the right of jury trial on the common law transaction may be preserved only if the court is required to try the common law issue so that judgment on the verdict is entered before the equitable claims are decided. This is the view held by Judge Moscowitz in *Elkins v. Nobel*, 1 F. R. D. 357, 358, and Judge Conger in *Dellefield v. Blockdel Realty Co.*, D. C., 1 F. R. D. 689, 690.

"We agree with these judges that the Federal Rules of Civil Procedure make such a preservation of the demanded right of jury trial and that to that end the trial judge is required to try and determine that issue before the other. The rules introduce the radical change in the federal practice of creating the jurisdiction in the District Courts to hear and determine in a single suit equity claims, with a claim which therefore could have a common law adjudication in a separate suit."

The *Bruckman* decision, *supra* clearly supports petitioner's position that plaintiff in the present case had the right, based on the original complaint, to demand a jury trial on the issue of damages and as clearly conflicts with the holding by the Circuit Court of Appeals for the Second Circuit 161 Fed. 2nd 499, that he did not have that right. The only difference between the two cases is that in the cited case plaintiff duly demanded that right, while in the instant case that right was not demanded and the right was waived.

## POINT III

**Plaintiff by failure to follow procedure permitted and required by the rules, elected to proceed without a jury and deliberately waived his opportunity to demand a jury as of right.**

The Circuit Court of Appeals for the Sixth Circuit waited for and followed the lead of the Second Circuit in a petition brought by the same plaintiff in the instant proceeding on identical circumstances against another respondent. The opinion was rendered on June 30, 1947, but is not yet officially reported. (*Bereslavsky v. Kloebe*, U. S. D. J. 74 U. S. P. Q. 79.)

If the holding of the Circuit Court of Appeals, Second Circuit and the Sixth Circuit, that a complaint requesting both equitable relief and damages will not support a demand for jury trial, is correct under the Rules creating one form of action and unifying procedure, then it must follow that plaintiff, in bringing his action in such form and failing to include in his complaint a separate cause seeking damages only, has elected to proceed without a jury and has deliberately waived the right to jury preserved and accorded him by the Rules.

The Circuit Court of Appeals for the Ninth Circuit in its opinion in *Bruckman v. Hollzer* (*supra*), ably states the purpose and application of the Rules where at page 733 it says:

"We regard the rules enlarging the powers of the single tribunal to hear and determine equitable and legal transactions in which the pre-existing right to jury trial is to be preserved, as a long forward step in our judicial procedure. We consider one of its major purposes is to remove the expensive and time-

losing requirement of two separate suits to give to the litigant his jury as well as his equitable relief. We are not in accord with the extreme judicial conservatism which instinctively clings to outmoded intricate processes and would seek to nullify or minimize every attempt for their simplification."

Thus, it is apparent that the views of the Circuit Court of Appeals, Second and Sixth Circuits, are divergent from and in conflict with those of the Ninth Circuit, a condition which leaves the application of the Rules on the instant questions in a state of uncertainty and requires reconciliation by this Court.

### CONCLUSION

For the reasons herein set forth the petition for Writ of Certiorari should be allowed.

Respectfully submitted,

HERBERT C. SMYTH, JR.,  
FRANK S. BUSSEY,  
*Attorneys for Petitioner.*

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CLERK

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1947

No. 244

EUPHIME V. BERESLAVSKY,  
(Plaintiff in Civil Action No. 26-575 against  
Socony-Vacuum Oil Company, Incorporated),

v.

FRANCIS G. CAFFEY,  
United States District Judge for the  
Southern District of New York,  
*Respondent and Petitioner.*

**BRIEF OF EUPHIME V. BERESLAVSKY IN OPPOSITION  
TO PETITION FOR WRIT OF CERTIORARI**

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— — — — —

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1947

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No.

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(Plaintiff in Civil Action No. 26-575 against  
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**BRIEF OF EUPHIME V. BERESLAVSKY IN OPPOSITION  
TO PETITION FOR WRIT OF CERTIORARI**

The petition for certiorari, as a basis for asking this Court's review, postulates a question not presented to the Circuit Courts of Appeals for the Second and Sixth Circuits. Building upon this fictitious postulate, petitioner's counsel asserts a conflict with a decision of the Circuit Court of Appeals for the Ninth Circuit and a vital public interest by reason of the constitutional right to a jury trial. Neither the conflict nor the interest exists in fact.

The original complaint in the action entitled *Euphime V. Bereslavsky*, Plaintiff, v. *Socony-Vacuum Oil Company, Inc.*, Defendant, United States District Court for the

Southern District of New York, Civil Action No. 26-575, pleaded a single cause of action for patent infringement under R. S. § 4921 (Title 35, § 70, U. S. Code). The prayer for relief read as follows:

“WHEREFORE, plaintiff demands a preliminary and final injunction against further infringement by defendant and those controlled by defendant, an accounting for profits and damages, and an assessment of costs against the defendant.”

Section 4921 of the *Revised Statutes* is the equity section of the patent laws vesting the district courts with the power to grant injunctions according to the course and principles of courts of equity and providing for an accounting of profits and an assessment of damages. Plaintiff, upon the filing of this complaint, had no right to a jury trial on any issue presented by his pleading, and this was so held by the Circuit Courts of Appeals for both the Second and Sixth Circuits.

By amendment the action was transformed into an action on the case under R. S. § 4919 (Title 35, § 67, U. S. Code), and the prayer for relief was changed so as to demand a sum of money only in the following words:

“WHEREFORE, plaintiff demands judgment against defendant in the sum of \$2,500,000, interest and costs.”

A legal issue thus being raised for the first time, plaintiff promptly filed his request for a jury. The District Court (The Honorable Francis G. Caffey, the nominal petitioner here) upon motion of Socony-Vacuum Oil Company, Inc., ordered the jury demand stricken.

Following the procedure suggested by this Court in *Los Angeles Brush Corp. v. James*, 272 U. S. 701 (1927), a petition for mandamus was presented to the Circuit Court of Appeals for the Second Circuit, which Court

granted the petition, directed the vacation of Judge Caffey's order and reinstated plaintiff's action as an action triable by a jury.

It is respectfully submitted that upon the reasoning and authorities set out in the opinions of the Circuit Courts of Appeals for the Second Circuit and for the Sixth Circuit, the granting of the writ of mandamus was proper. For the convenience of the Court a copy of the decision of the Circuit Court of Appeals for the Sixth Circuit in *Bereslavsky v. Klobb*, — F. 2d —; 74 USPQ 79, is printed in the appendix hereto.

The petition for a writ of certiorari should be denied.

Respectfully,

W. B. MORTON,  
Attorney for Plaintiff.

LOUIS D. FORWARD,  
CURT VON BOETTICHER, JR.,  
W. B. MORTON, JR.,  
of Counsel.

New York, N. Y.,  
September 2, 1947.

## Appendix

No. 10451

### UNITED STATES CIRCUIT COURT OF APPEALS, SIXTH CIRCUIT.

EUPHIME V. BERESLAVSKY,

*Petitioner,*

v.

HONORABLE FRANK L. KLOEB, United  
States District Judge,

*Respondent.*

    } PETITION for Writ  
    } of Mandamus.

Decided June 30, 1947.

Before SIMONS, ALLEN and MILLER, Circuit Judges.

SIMONS, Circuit Judge. The petitioner is plaintiff in a patent infringement suit begun by bill in equity against the Sun Oil Company, seeking the usual injunction and accounting. On July 21, 1945, the Judge Advocate General of the Army requested that trial therein and in a similar suit pending in New York, be postponed until after the war emergency, because the patent involved data, the disclosure of which might be inimical to the United States. Conforming to the request both causes were removed from the trial calendars in their respective courts. On May 21, 1946, the patent in suit expired. Thereafter, on August 27, the petitioner moved for leave to amend his petition, striking the prayer for equitable relief and accounting under

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R. S. § 4921, 35 U. S. C. A. 70, and substituting therefor a prayer for money damages under R. S. § 4919, 35 U. S. C. A. 67, and an order granting the motion was entered September 24.

On October 2, 1946, an amended complaint was filed seeking money damages, and five days thereafter the plaintiff demanded a jury trial pursuant to Rule 38 of the Federal Rules of Civil Procedure. On February 10, 1947, the Sun Oil Company, defendant, moved to strike the order granting petitioner's jury demand. The motion was granted by the district judge on February 25, 1947. The writ of mandamus is sought to direct the court to vacate his order.

The problem is identical with that resolved by the Second Circuit Court of Appeals in *Bereslavsky v. Caffey, District Judge*, ... Fed. (2d) ..., on May 7, 1947. There the writ was granted with a supporting opinion that would seem adequately to dispose of the present cause were it not for the respondent's insistence that the question have our independent and fully considered judgment. Rule 38 provides that any party may demand a trial by jury of any issue triable of right by making written demand therefor, but not later than ten days after the service of the last pleading directed to the issue, and that failure to serve such demand constitutes a waiver of jury trial. The petitioner's position is that at the time of the filing of the last original pleading he could not have asked for a jury because the action was then cognizable solely in equity, and it was not until the amended complaint for damages was filed that his right to a jury arose. The respondent contends that the petitioner could have demanded a jury trial in the original action under § 4921, and not having done so waived the right. Its principal argument in support of that contention is that the Rules of Civil Procedure have eliminated all procedural differences between law and equity.

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The power of the court, in aid of its appellate jurisdiction, to issue the writ now prayed, is not and may not be questioned. *Ex Parte Peru*, 318 U. S. 578; *United States Alkali Assn. v. U. S.* 325 U. S. 196, 204. Section 4921 vests in the several district courts of the United States, jurisdiction in cases arising under the patent laws and authorizes the granting of injunctions according to the course and principles of courts of equity to prevent the violation of any rights secured by patent, and empowers the court to grant recovery of profits and damages. While the Rules of Civil Procedure (Rule 2) provide for one form of action, we agree with the Second Circuit Court of Appeals that they have not completely obliterated for all purposes, the historic differences between law and equity. They have, for the purpose of achieving a simplified procedure, abolished technical differences, but cases that historically were equitable are still to be tried to the court, and those that were legal, to the jury. It is true that the Chancellor may separate legal issues and send them to the jury once equitable issues have been disposed of, but this does not prevent him from exercising his historic power to dispose of the whole case as Chancellor. *Beaunit Mills v. Eday Fabric Sales Corp.*, 124 Fed. (2d) 563 (C. C. A. 2); *Bellavance v. Plastic-Craft Novelty Co.*, 30 Fed. Supp. 37 (D. C. Mass.); *Williams v. Collier*, 32 Fed. Supp. 321 (D. C. Pennsylvania).

Section 4921 speaks in terms clearly equitable. As was said by the court in the *Beaunit Mills* case, supra, "It is true that on issues of patent infringement a jury trial may be had under a claim for damages only, 35 U. S. C. A. § 67 (R. S. 4919), as distinguished from a claim for injunction and accounting of profits. 35 U. S. C. A. § 70 (R. S. 4921). Here . . . the complaint . . . is framed along equitable lines looking to injunctive relief, both prohibitory and mandatory in character, as well as an accounting, to-

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gether with declaratory relief. . . . This appears to stamp it as presenting equitable issues only, . . . ; and hence when the district judge acted, he was correct in denying jury trial. But this does not necessarily mean that a jury issue may not later develop. . . . If, however, issues of a legal nature are later developed, the question of jury trial will have to be determined in the light of the then status of the case." In the *Bellavance* case, *supra*, it was held that where the cause was equitable in nature and the relief sought was equitable, the fact that damages were also sought for past infringement did not entitle the plaintiff to a jury trial on the issue of damages. The court said, "The distinction between Law and Equity, abolished by the new rules, is a distinction in procedure and not a distinction between remedies." See also *Barton v. Barbour*, 104 U. S. 126, 133. It is, of course, true that under § 2 R. S., 28 U. S. C. A. 772, district courts sitting in equity for the trial of patent cases may impanel a jury and submit to it such questions of fact as the court may deem expedient, the verdict of the jury being binding upon the court, but this does not mean that a trial by jury in such causes is a matter of right. The calling of the jury is within the discretion of the court, Federal Rules of Civil Procedure, Rule 39; *Keys v. Pueblo Smelting, etc. Co.*, 31 Fed. 560 (C. C. Colo.), and such discretion may be exercised even in cases where the plaintiff, having a right to jury trial, waives the right by failure to make timely demand. *Goldman Theatres v. Kirkpatrick*, 154 Fed. (2d) 66 (C. C. A. 3).

The contention that the plaintiff in his amended complaint states no new issue, may be true, but the amended complaint states a different cause of action. In the one case an equitable remedy is sought and damages are but incidental to the main prayer for relief. In the other damages constitute the sole ground for the action. It is our view that the petitioner could not have demanded a jury

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trial at the time of the original pleading because the suit was then exclusively in equity, even though a right to trial by jury might subsequently have arisen upon an adjudication of validity and infringement. For an application of the principle that one does not, by non-action, waive a right when there is no basis for choice, and where the elements from which selection must be made and which alone give it meaning, have not yet come into existence, see *Gentsch v. Goodyear Tire & Rubber Co.*, 151 Fed. (2d) 997, 1000 (C. C. A. 6); *Buckley v. Commr.*, 158 Fed. (2d) 158 (C. C. A. 2).

The writ will issue directing the respondent to vacate the order striking the jury demand.